

REMARKS/ARGUMENTS

This amendment is filed in response to the Final Office Action mailed November 2, 2006. In this Amendment, claim 1 is amended. Claim 7 was previously cancelled. Following entry of this amendment, claims 1-6 and 8 shall be pending.

In the Final Office Action, claims 1-6 and 8 have been rejected based on various prior art grounds. The applicant hereby requests reconsideration of claims 1-6 and 8 in view of the amendments and reasons set forth below.

- I. REJECTIONS UNDER 35 USC § 103(A) BASED ON U.S. PAT. APPLICATION PUB. NO. 2004/0207809 BLACKBURN ET AL. U.S. PAT. NO. 6,113,813 GOUDJIL, U.S. PAT. NO. 4,962, 013 TATEOKA ET AL., U.S. PAT. NO. 5,449,558 HASEWAGA ET AL., AND U.S. PAT. NO. 6,309,313 PETER.

At paragraphs 3 and 4 of the Office Action, Claims 1-6 and 8 were rejected under 35 U.S.C. 102(a) as being unpatentable over various combinations of the above-cited references. The primary references relied upon in these rejections is *Blackburn* and/or *Goudjil*. For the reasons set forth below, these rejections are hereby traversed.

Turning first to *Blackburn*, Applicant submits that *Blackburn* is at least deficient in that it does not teach or suggest a cast and cured polyurethane film layer, said polyurethane film layer being sandwiched between a thin inner and a thin outer protective resin substrate sheet as is now recited in amended claim 1. Despite the assertions of the Examiner, neither the polymer substrate disclosed in paragraph [0022], nor the acrylate-based film of paragraph [0024], nor the abrasion-resistant coating of paragraph [0025] are properly construed as a thin protective resin substrate sheet as now claimed. The polymer substrate [0022] is not thin as compared to the other layers and the layers of paragraphs [0024] and [0025] are not substrate sheets at all let alone thin substrate sheets as claimed. The layers of [0024] and [0025] are merely film coatings applied in liquid form over the photochromic coating of paragraph [0023].

Blackburn is further deficient as it does not teach the **absence** of a UV light absorber as also recited in amended claim 1. Instead *Blackburn* states that “UV absorbers are merely “optionally used”. Therefore, one of ordinary skill in the art would not look to *Blackburn* in considering the presently claimed invention.

Lastly, *Blackburn* simply teaches away from the present invention, particularly as to the film layer being sandwiched between a thin inner and a thin outer protective resin substrate sheet as claimed. For example, it is well-known by persons of ordinary skill in the art that the types of coatings disclosed in *Blackburn* are applied via one of two application methods: either dip coating or spin coating methods. And neither of these methods is known to be used to create a resin substrate sheet that is later used as either an inner or outer layer in a laminate. Therefore, Applicant submits that one of ordinary skill in the art simply would not look to *Blackburn* in the first place as relates to the presently claimed invention.

Turning next to the *Goudjil* reference, this reference does not make up for the deficiencies of *Blackburn*. Moreover, *Goudjil* itself is deficient.

For example, the Examiner has asserted that “*Goudjil* discloses the instantly claimed films and laminates at the abstract.” However, the undersigned can find no disclosure, suggestion or teaching in *Goudjil* to support the Examiner’s assertion. In fact, it appears to the undersigned that *Goudjil* is devoted exclusively to one layer of material. See, for example, the entire “Description of the Preferred Embodiment,” as shown at columns 5-7 of the *Goudjil* reference. It discloses only a single acrylic resin sheet with photochromic compounds incorporated therein.

Goudjil is further deficient insofar as the presently claimed thickness of the cast and cured photochromic polyurethane film layer is not disclosed in *Goudjil*. Specifically, the one layer of “acrylic shield” material disclosed in *Goudjil*, as shown at column 6, lines 14-15, was “fabricated with thicknesses of 0.100 and 0.060 inch.” These disclosed thicknesses are well outside the presently claimed thickness of 10 to 250 microns.

Goudjil is further deficient as providing any motivation to combine its teachings with *Blackburn*. In this regard, the Examiner asserts that it would be obvious to combine the teachings of *Goudjil* with *Blackburn* because *Goudjil* discloses a “soft plastic” and that it is well known to protect soft plastics with hard layers as taught by *Blackburn*. However, since the very nature of the *Goudjil* device is to provide protection and since *Goudjil* says nothing about needing further layers of protection for the plastic shield to perform its intended function, the only motivation to somehow conclude that *Goudjil* needs had yet further “protective” layers must come from the presently claimed invention, not from anything internally disclosed in *Goudjil*. Hence, the Examiner is clearly relying on improper hindsight for any combination of *Goudjil* with *Blackburn*.

Yet still further, *Goudjil* is deficient disclosing a change in b^* of CIELAB as claimed. In this regard, the Examiner seems to assert that the mere disclosure of Stabilizer systems including HALS and antioxidants in *Goudjil* somehow automatically leads to the conclusion that *Goudjil* will achieve the change in b^* as claimed. However, numerous other factors contribute to a change in b^* beyond the mere presence of the disclosed formulation. One such factor is oxidation since photochromes oxidate and degrade when exposed to air. And since the photochromes in *Goudjil* are incorporated into an acrylic shield that is exposed to the air at surface of the shield, it would be clear to one of ordinary skill in the art that the photochromes in the *Goudjil* device would immediately start to oxidate following molding of the shield. This would have a material effect both on the light fatigue of the photochromes in the shield and on the yellowness of the shield. Moreover, it is clearly contrary to the present invention where the photochromes are protected from oxidation by virtue of the protective resin layer substrate sheets. Hence, the Examiner cannot properly assert that the mere presence of the stabilizer systems, including HALS and antioxidants disclosed in *Goudjil* would lead to a system that satisfies the b^* limitation as claimed.

In sum, it is apparent that the *Blackburn* and *Goudjil* references are both individually and collectively deficient as to the invention recited in amended claim 1.

Nor is there any proper motivation to combine *Blackburn* and *Goudjil* even if they were not deficient. Finally, neither the *Tateoka*, *Peter* nor *Hasegawa* references make up for the deficiencies of *Blackburn* and/or *Goudjil*. Hence, it is apparent that the invention as claimed is patentable over the cited prior art in the rejection and that claim 1 should be allowed.

As to claims 2-6 and 8, these claims depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

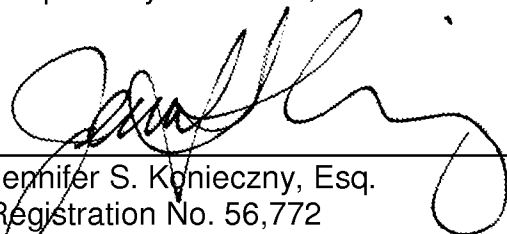
CONCLUSION

In view of the foregoing, it is demonstrated that none of the prior art cited renders obvious, alone or in combination, currently pending claims 1-6 and 8. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,



Jennifer S. Konieczny, Esq.
Registration No. 56,772

Dated: March 2, 2007

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
2281 W. 190th Street, Suite 200
Torrance, CA 90504
Telephone: (310) 755-7800
Facsimile: (310) 327-3466

Customer No. 37,374